

Appln. No. 10/624,857
Amendment dated July 14, 2008
Reply to Office Action mailed May 13, 2008

REMARKS

Reconsideration is respectfully requested.

Claims 1 through 29 remain in this application. No claims have been cancelled. No claims have been withdrawn or added.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

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Claims 1 through 29 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Burnstein and DRM.

As previously noted, claim 1 requires "receiving a diagnostic code generated by a computer system for a component of the computer system", "generating an authentication code for the generated diagnostic code" and "associating the authenticating code with the diagnostic code for the component of the computer system". Claim 9 requires "a diagnostic module on a computer system operable to perform a diagnostic on a component of the computer system and to generate a diagnostic code by the performance of the diagnostic" and "an authentication code generation module on the computer system operable to generate an authentication code associated with the diagnostic code in response to the generation of the diagnostic code by the diagnostic module". Claim 15 requires "receiving a diagnostic code generated by a computer system for a component of the computer system", generating an authentication code in response to receiving the diagnostic code", and "associating the authentication code with the diagnostic code".

In the "Response to arguments" section of the final Office Action, it is alleged that:

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., special meanings of

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authentication code, associated, diagnostic code, etc.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant has argued regarding the "diagnostic code" and "authentication code." Applicant's arguments clearly show assumptions regarding "diagnostic code" and "authentication code." These assumptions are not reflected in the claim language itself. For example, Applicant argues that these diagnostic codes and authentication codes have such special properties when "associated." What is "associated"? Applicant seems to mean more than the typical meaning of this word "associated." For example, Burnstein clearly teaches authentication. Authentication leads to access to previously unaccessible data. What is more natural than this? Yet, Applicant seems to mean more than this by insisting that "associated" requires more than this. As for diagnostic code, this concept is taught by DRM itself. Thus, a reasonable combination of DRM and Burnstein is the currently claimed invention.

It is submitted that, while it is agreed that the terms used in the claims do not necessarily inherit all limitations set forth in the specification, this does not mean that the terms themselves are devoid of any meaning to one of ordinary skill in the art, which is the point of view from which the terms must be considered. As pointed out below, the Burstein patent describes an authentication process that is performed and completed prior to any further communication. (Note that Burstein says that "[o]nce logged in or otherwise authenticated through a screen like that illustrated in FIG. 2, [then] a screen such as that illustrated in FIG. 3 appears to prompt for the domain name to be modified or managed by the operator" (implied word inserted).) There is no suggestion that the authentication information that is received as a part of the initial authentication process is associated with anything that might be interpreted by one of ordinary skill in the art as a diagnostic code. Instead, the Burstein patent discusses encryption of the subsequent communications rather than any authentication associated with any diagnostic codes. It is therefore submitted that there is no association between the authentication process which occurs initially and independently of the further operations.

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Further, the portion of the "Response" reproduced above contends that "Applicant's arguments clearly show assumptions regarding "diagnostic code" and "authentication code", but then the further discussion and example relates to the term "associating" in the claims.

Also, the concept of "a reasonable combination" of art does not appear to be based upon the requirements of the law., and in any event, as pointed out below, even if one believes that the allegedly obvious combination is "a reasonable combination", that does not make up for the fact that neither of the documents disclose significant requirements of the claims.

The "Response to arguments" section of the final Office Action further states that

Two other issues are genuinely puzzling and any resolution of either issue may perhaps expedite prosecution. First. Applicant (in the Remarks) mentions a "primary" reference. The patent law no longer recognizes any significance of a "primary" reference. Nevertheless, Applicant may have meant to communicate something that the Examiner has missed. Applicant is respectfully requested to make known (if any) particular meaning attached to the concept of "primary" reference - preferably before the prosecution is no longer ex parte with the Examiner, i.e., at the Board of Appeals.

With respect to the reference to one of the documents as the "primary" reference, it is submitted that, irrespective of any terminology used for identifying documents used in a rejection, the U.S.P.T.O. bears the burden, in setting forth a prima facie case of obviousness, that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify, or otherwise combine, one teaching (customarily referred to as the "primary reference") with aspects of another reference (customarily referred to as the "secondary reference"). While the terminology is used more as a matter of convenience to indicate which of the references is being modified by which reference(s), the use (or non-use) of this terminology does not change the burden upon the U.S.P.T.O. in setting forth a prima facie case of

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obviousness. In this case, the statement in the previous response was merely made to indicate that the substance of the rejection appeared to be based upon an allegedly obvious modification of the DRM teaching by the Burstein teaching.

The "Response to arguments" section further states that (emphasis in original):

Second. Applicant has cited passages of Burnstein that cannot and would not be physically combined with DRM. At no time, the Examiner has indicated that the rejection was based on a physical combination (e.g., lock into an attaching hook, plug into an electrical outlet, etc.) of Burnstein and DRM. In the art of the references and of the Applicant, no one thinks in terms of physical combination. Instead, Applicant may know of reasons why the concepts of Burnstein and the concepts of DRM would not be combined so as to produce the claimed invention. In the process of providing such reasons, Applicant may end up amending the claims so as to put more limiting terms in the sense of the Applicant's attempted arguments themselves. If so, Applicant may be providing reasons that permit USPTO to issue a patent.

A thorough check (including word searches and a careful reading) of the two preceding responses filed by the undersigned reveals no mention of "physical" or "physical combination" in any argument. Thus, it is submitted that this is not an issue, but the undersigned will provide a further answer if the response to this paper includes a more specific indication of where the term "physical" appears in the previous arguments.

The "Response" section further contends that:

For examples:

(1) what is a diagnostic code? Is this a code which diagnoses the component of the computer? An adjective of "diagnostic" does not narrow the meaning even to such a code. The adjective "diagnostic" does not necessarily distinguish between (a) a code that is associated with a diagnosis and (b) a code that diagnoses the component for errors in operation and (c) a code that diagnoses the computer system for errors in operation and (d) a code that is a by-product of a diagnosis and (e) a code that happens to share a computer system with other code that conducts diagnosis and (f) many other types of codes.

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(2) what is "associating"? Associating can mean many things such as (a) attached, i.e., linked during or before or after compiling of code (b) functional attachment, i.e., a code needing another code for functioning - e.g., function calls, class overloading which needs another class for correct referencing, etc. (c) or more likely in this application, something entirely different meaning.

(3) what is an authentication code? What does it authenticate? Is this a code which authenticates a component of the computer as being legitimately obtained by the user? An adjective of "diagnostic" does not narrow the meaning even to such a code. The adjective "diagnostic" does not necessarily distinguish between many meanings.

It is submitted that the above questions do not overcome the simple fact that the Burstein patent discusses authentication information for a person ("operator" or "agent"), and not for anything meeting any of the alternatives discussed for a "diagnostic code", and clearly the Burstein patent does not establish that the "authentication information" provided by the operator is in any way "generat[ed]... for the *generated* diagnostic code". The language of the claims does not merely recite adjectives for the codes, but includes substantive requirements that do not appear to have been considered here. See, especially, claim 15 which requires "receiving a diagnostic code generated by a computer system for a component of the computer system", "generating an authentication code in response to receiving the diagnostic code", and "associating the authentication code with the diagnostic code." Clearly, the causal requirements set forth in claim 15 are not met by the allegedly obvious combination of DRM and Burstein.

Turning now to the rejections of the Office Action, as previously pointed out, it is conceded in the rejection of the Office Action that the DRM document does not disclose this requirement of the claims, but it is then asserted that:

Burnstein teaches "generating an authentication code (column 10, line 24 to column 11, line 26, i.e., authentication such as by using start screen and domain manager) associated with the diagnostic code (column 14, line 61 to column 15, line 67; figure 4; claims 15, 16 of Burnstein i.e. diagnostic tools used after authentication permits the use of diagnostic tools)" for the motivation of permitting an agent to

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register and manage a plurality of domain names for a plurality of different registrants (column 3, lines 5-60) thereby including the use of diagnostics (for management) upon proper authentication (such as would be necessary for an agent).

And it is further asserted that:

Hence, it would have been obvious to those of ordinary skill in the art at the time of the claimed invention to combine the teachings of Burnstein and DRM for the motivation noted in the previous paragraphs so as to teach the claimed invention.

Turning to the referenced portion of the Burstein patent, it is stated at col. 10, line 24 through col. 11, line 26 that (emphasis added):

Having described the overall structure, this discussion now turns to illustrations of how particularly useful functions are implemented in a preferred aspect of the present invention. Referring to FIG. 2, a start screen generated by the front-end domain manager is illustrated. In this illustrative implementation, it is assumed that the operator accessing the domain manager is acting as an agent for a domain name registrant to modify some information about the domain name or perform another domain management function. Such a start screen preferably requests identification and authentication information from the operator to ensure that the agent is authorized to use the domain manager and to make changes for that domain. The authentication information is collected by the front-end of the domain manager and passed to the back-end domain server for confirmation. Once logged in or otherwise authenticated through a screen like that illustrated in FIG. 2, a screen such as that illustrated in FIG. 3 appears to prompt for the domain name to be modified or managed by the operator. All communications following the authentication screen are preferably encrypted between the front-end server and the back-end server. The operator enters the domain name to be active for the initial portion of the session and sends the message to the front-end server. The operator sends the name to the front-end domain manager server, which accesses information about the domain name from the back-end server and returns a function select screen.

Information is gathered about the domain name by the back-end server and passed to the front-end server. The front-end domain manager server sends a screen that allows the operator to select the management functionality to be executed. For example, the front-end domain manager may cause display of a screen like that illustrated in FIG. 4. Most preferably, the returned function screen illustrates all of the functions that can be performed on that domain name by that operator. It should be appreciated that certain functionality is accessible only to the original or authorized registrar for a domain name and so certain registrant agents may be unable to perform certain maintenance or management functions. When the agent initially registered the domain name for the registrant through the domain manager, the agent is preferably automatically recognized as authoritative for that domain name. An agent is also preferably recognized as authoritative when the agent has previously accessed the domain manager and received authentication for that particular domain name.

For agents not already recognized as authoritative, further authentication is preferably requested. Operators that are technical contacts or domain name administrators

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may enter a domain name to be managed and the front-end domain manager issues a screen such as that illustrated in FIG. 5 to request further authentication. As shown in this example, the screen generated by the front-end domain manager might inform the operator not already recognized as authoritative that the operator is asking to be recognized as the authoritative zone and technical contact of the indicated domain name. The screen of FIG. 5 indicates that authorization for the operator's request must be confirmed from the administrative contact for the domain name. The operator clicks on the appropriate button to indicate that the indicated action is desired. The front-end of the domain manager sends a command to the back-end domain manager, which sends an e-mail to the administrative contact for the domain name and waits for confirmation from the administrative contact that authorization is proper. Upon authorization, the back-end domain manager recognizes the operator as the authoritative zone and technical contact for that domain name and sends an appropriate message through the front-end domain manager to the operator.

It is submitted that the Burstein patent does not disclose, either here or elsewhere in the patent, the "generat[ion of] an authentication code [that is] associated with the diagnostic code" as required by claim 1. Instead, the Burstein patent discusses the authorization of an "agent", and thus it is the agent that is authorized and not any element or item, such as, for example, any diagnostic code. It is submitted that one of ordinary skill in the art would understand that it is the operator/agent that *provides* the authentication information, and that the information is not *generated* by the Burstein system. At most, one might interpret that an agent is assigned an "authentication" that must be supplied for the initial authentication of the agent, but this does not disclose generating an authentication code "for the generated diagnostic code", as it is unclear as to how the agent provides "authentication information" to the Burstein system. In fact, it is submitted that the cited art could only lead one of ordinary skill in the art away from the requirements of the claims, as, again, it discusses authentication information for the agent (and not for any particular diagnostic code) that is not "generat[ed]...for the generated diagnostic code" as required by claim 1.

In connection with this, it should be noted that claim 25 requires that "a user is incapable of generating the authentication code". The cited portion of the Burstein patent conflicts with this, particularly at col. 10, lines 28 through 38, where it states (emphasis added):

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In this illustrative implementation, it is assumed that the operator accessing the domain manager is acting as an agent for a domain name registrant to modify some information about the domain name or perform another domain management function. Such a start screen preferably requests identification and authentication information from the operator to ensure that the agent is authorized to use the domain manager and to make changes for that domain.

Thus, the disclosure of Burstein is in conflict with the requirements of claim 25. Claim 25 was previously presented but the pending Office Action did not explain how Burstein teaches this requirement, which is contrary to the manner in which the operator in Burstein provides the "authentication information".

Also, claim 26 requires that "the authenticating code is generated without user intervention". This requirement is also contrary to the cited statements in the Burstein patent set forth above that the operator supplies the "authentication information".

Further, claim 27 requires that "the authentication code is generated by the computer system", which is contrary to Burstein's requirement that the operator supply the "authentication information".

Still further, claim 24 requires that "the authentication code generated is unique to the diagnostic code received", which is contrary to the discussion in Burstein patent that the "authentication information" is assigned to the operator and the operator uses the same "authentication information" at each log in.

Claim 23 requires that "the generating of the authentication code is performed after the receiving of the diagnostic code", and this is in conflict with the discussion in Burstein in which the operator supplies the "authentication information" in order to log in, which appears to be *prior to* any receipt of a diagnostic code.

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Claim 28 requires "requesting an authentication code by the computer system after receiving the diagnostic code" and claim 29 requires that "generating the authentication code is performed in response to receiving the diagnostic code", which is different from Burstein for the reasons set forth above with respect to claim 23.

The rejection further cites the Burstein patent at col. 14, line 61 through col. 15, line 67, but nothing there discloses the origin of the authentication information or that the authentication information is associated with a diagnostic code, as opposed to an agent as previously noted, or that any authenticating code is generated in response to the reception of a diagnostic code and is associated with that diagnostic code or is unique to that code.

It is respectfully submitted that, for the purpose of a compact prosecution, if the rejection is maintained, that the specific portions of the Burstein patent that are relied upon as disclosing the origin and timing of the creating of the "authentication information" by the Office be cited, rather than rather large and general portions of the patent that appear to discuss things unrelated to the "authentication information".

With respect to claims 18 through 29, it is stated in the rejection of the Office Action that (emphasis added):

Regarding claim 17 (authentication code using serial number, etc.), such particular features are well known in the art for the purpose of security and for the purpose of keeping track of data. Regarding claims 18-29, such particular features are well known in the art for the purpose of security.

The allegation in the rejection that the "particular features" of claims 2, 3, and 18 through 29 "are well-known in the art for the purpose of security" is hereby challenged under MPEP §2144.03 (B), which states:

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B. If Official Notice Is Taken of a Fact, Unsupported by Documentary Evidence, the Technical Line of Reasoning Underlying a Decision To Take Such Notice Must Be Clear and Unmistakable

If such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice so as to adequately traverse the rejection< in the next reply after the Office action in which the common knowledge statement was made.

The contention that the requirements of claims 2, 3, and 18 through 29 are “well known” is generally challenged on the basis that the rejection does not “provide specific factual findings predicated on sound technical and scientific reasoning” applied to the requirements of each of these claims, and the rejection further fails to provide the reasoning why such allegedly well known features would be obvious modifications of the cited art.

It is further noted that claims 18 through 29 include particular examples in which the contention of “well-known in the art” is deemed to be particularly inappropriate. For example, claim 20 requires that the method further include “receiving a file of valid authentication codes and wherein generating the authentication code comprises selecting the authentication code from the file of valid authentication codes.” It is submitted that that is not well known in the art, and that the modification of the hypothetical combination of DRM and Burstein to include this feature would not be obvious..

Further, claim 22 requires that “generating the authentication code comprises receiving the authentication code from a server”. Again, it is submitted that this is not well known in art for the purpose of security, and is foreign to the hypothetical combination of DRM and Burstein. Also, claim 23 requires that “the generating of the authentication code is

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performed after the receiving of the diagnostic code". It is submitted that this requirement of timing is not "well known" for the "purpose[s] of security", and if the assertion of "well known" is maintained, then applicants respectfully request that this be explicitly explained as required by MPEP §2144.03.

Claim 24 requires that "the authentication code generated is unique to the diagnostic code received". This is submitted to distinguish the claimed system from the allegedly obvious combination of DRM and Burstein.

Claim 25 requires that "a user is incapable of generating the authentication code", claim 26 requires that "the authenticating code is generated without user intervention", and claim 27 requires that "the authentication code is generated by the computer system". It is submitted that each of these is not well known, and further distinguish the claimed invention from the allegedly obvious combination.

Further, claim 28 requires "requesting an authentication code by the computer system after receiving the diagnostic code" and claim 29 requires that "generating the authentication code is performed in response to receiving the diagnostic code". It is also submitted that these features have not been established as being well known for the purpose of security, and further explanation is requested, especially since these features distinguish the claimed invention from the DRM-Burstein combination.

It is therefore submitted that the cited documents, and especially the allegedly obvious combination of Burnstein and the DRM document set forth in the rejection of the Office Action, would not lead one skilled in the art to the applicant's invention as required by claims 1, 9 and 15. Further, claims 2 through 8 and 23 through 29, which depend from claim 1, claims 10 through 14, which depend from claim 9, and claims 16 through 22, which depend from claim 15 also include the requirements discussed above and

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therefore are also submitted to be in condition for allowance.

Withdrawal of the §103(a) rejection of claims 1 through 29 is therefore respectfully requested.

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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